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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,404

05/24/2006

Shingo Sakakibara

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EXAMINER

BUIE, NICOLE M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,404	Applicant(s) SAKAKIBARA ET AL.	
	Examiner NICOLE M. BUIE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/30/2009 has been entered.

Response to Amendment

The amendment filed on 01/30/2009 has been entered. Claims 17-21 remain pending in the application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-114884 (see human translation for citation).

Regarding claims 17 and 20, JP '884 discloses insulating material of a fluororesin for an electric wire, wherein said fluororesin comprises a tetrafluoroethylene/perfluoro (alkyl vinyl ether) copolymer (Claim 1, [0007]) having a perfluoro(alkyl vinyl ether) unit content of 0.5 to 5.0 mole percent relative to all monomer units which overlaps the claimed range. It would have been obvious to one of ordinary skill in the art at the time of invention to have selected the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP 2144.05. Specifically, JP '884 discloses extrusion molding of a fluororesin into tubes, wherein electrical wires are intended to be within the said tubes [0023].

The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. critical shear rate would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Art Unit: 1796

Regarding claim 19, JP '884 discloses an insulating material wherein a fluororesin has a melt flow rate, at 372°C, of from 20 to 750 g/10 minutes which overlaps the claimed range [0015].

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-114884 (see human translation for citation) as applied to claim 17 above, and further in view of Okumura et al. (US 2001/0022234).

Regarding claim 21, JP'884 discloses an electric material as shown above in claim 17.

However, JP'884 does not disclose a wire having a diameter of 0.02 to 0.13 mm. Okumura et al. teaches a wire with a diameter 0.09 to 0.15 mm coated with an insulating film, such as a tetrafluoroethylene/PAVE copolymer in [0039]-[0040]. JP'884 ([0007]-[0008]) and Okumura et al. [0002] are concerned with the same technical difficulty, namely improving electrical insulation of wires with an insulating material of TFE/PAVE copolymer. It would have been obvious to one of ordinary skill in the art at the time of invention to try a coating a wire as taught by Okumura et al. with a composition of JP'884 to improve electrical insulation.

Allowable Subject Matter

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1796

The following is a statement of reasons for the indication of allowable subject matter: the showing of unexpected results in Table 5 for claim 18 indicates that the claimed range has an improved MIT (cycle). Therefore, claim 18 is deemed nonobvious over the prior art of record.

Response to Arguments

Applicant's arguments filed 01/30/2009 have been fully considered but they are not persuasive. The following comments apply:

Art Unit: 1796

A) Applicants' argument that JP '884 (see translation for citation) does not disclose an electric wire insulating material is not persuasive. JP '884 discloses an electric insulating film which can be used as an electric wire insulating material [0002]. The recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

B) Applicants' argument that one of ordinary skill would not reasonably select a fluororesin having a PAVE content of at least 2.5 mol% (P3-4) is not persuasive. JP '884 discloses the amount of PAVE is from 0.5-5.0 which overlaps the claimed range [0007]. Therefore, JP '884 does not teach away from the instant claim range. Furthermore, it is known in the art that the MIT flex life increases with increasing amounts of PAVE as evidenced by Aten et al. (US 5,760,151) (C7/L45-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a higher amount of PAVE to increase the MIT flex life.

C) Applicants' assertion that there is no apparent reason which would lead one of ordinary skill to employ a TFE/PAVE copolymer alone to obtain the insulating material (P4) is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., TFE/PAVE copolymer alone) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant

Art Unit: 1796

claim only recites that a TFE/PAVE copolymer is used as an insulating material and that is explicitly taught in JP '884 in claim 1.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./
Examiner, Art Unit 1796
3/4/2009

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796

Application/Control Number: 10/580,404
Art Unit: 1796

Page 8